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Group Att Unit 1742

TO:	EXAMINER
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FROM:	James G. Staples
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REMARKS: ☒ Urgent ☒ For your review ☒ Reply ASAP ☐ Please Comment

If you do not receive all pages (5), please call confirmation number.

Dear Ex'r Wyszomierski :

Re: Pat. App. 08/991, 113

Per our just concluded tele con, a submission responsive to January 6, 2003, Office Action (paper 27) herewith.

Respectfully  
James G. Staples

Attorney Docket 183-U.S. 28  
1/26/03**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** Algirdas A. Underys )  
 )  
**Serial No.:** 08/991,113 )  
 )  
**Filing Date:** December 16, 1997 )  
 )  
**Title:** Heat Treatment Method and )  
 Apparatus )

**Attention:****Primary Examiner**  
Wyszomierski**Group 1742****RECEIVED**  
FEB 11 2003  
TC 1700

The Honorable Commissioner  
of Patents and Trademarks  
Washington, DC 20231

**ON REMAND**  
**FROM THE BOARD**  
(Formerly, and we believe still,  
Appeal No. 10,359)

**REMARKS - RESPONSIVE TO JANUARY 6, 2003 OFFICE ACTION**

The Examiner's basic contention, which is common to his rejection of claims 15, 4, 6, 7, 16, 17 and 19, is set out in lines 10 and 11 in his paragraph "2." on page 2 (really the third page) of his January 6, 2003, Office Action, as follows:

"... it appears that carrying out any process as defined in the '885 claims would necessarily produce a result in which one also carries out the process as defined by the present claims."

We do not believe this contention to be sustainable because (1) it is so vague as to be incapable of forming an understandable proposition, and (2) assuming it is construed to set out a comparison of processes, it is factually erroneous.

(1) the words "... carrying out any process as ... in ... '885 claims would ... produce

a result ... which ... also carries out the process ... (in) the present claims." is not susceptible of a precise meaning. It is not understood how a "result" which flows from a first process can carry out a second process; results do not "carry out" processes.

Applicant has no desire to be considered querulous or technical by the Examiner, but applicant respectfully contends that the Examiner's statement is unclear at the core of his position, and therefore the Examiner is respectfully requested to review and clarify the above quoted words in understandable language that is capable of being logically disputed.

(2) On the assumption that the Examiner meant that a person practicing any of the '885 processes would inherently carry out the processes of the application claims, his contention is erroneous.

A person carrying out the broadest of the '885 claims will produce a die block having two distinct zones of hardness: a first zone of two inches in depth which is a "softened" and "easily machineable" "shank portion", and a second zone, the balance of the die block, "whose initial prehardened condition is unchanged".

By contrast, a person carrying out broad claim 15 of the present application will produce, in a rod or a bar or a block (any block, not just a die block), a final object which has a uniform hardness throughout its entire mass due to processing in a conventional "heat treatment furnace". That resulting uniform hardness may be soft, hard, quenched and tempered, stress relieved or any of the other specialized conditions known in the art, but it will be uniform throughout the entire mass due to heat treatment furnace processing.

Since there is no similarity between claim 1 of the '885 patent and broad claim 15 of

this application, there is no basis for adding the temperature and coating references McGinty, Heath, Fielding, Erickson et al, Crossley or Westerberg et al to the base rejection.

Applicant has reviewed with care the Examiner's position set out in paragraph "6." on "page 4" of the Office Action but maintains that applicant's positions on all of sub-parts "a)" through "e)" thereof are persuasively controverted in pages 2-10 of its 17 October 2002 Amendment.

We must comment on the unfairness to applicant, from a legal point of view, of the subject double patenting rejection.

On December 16, 1997, the applicant herein filed this application on the use of infrared energy in the conventional furnace process of heat treating, a marked departure over the gas jet process which is over 100 years old.

Months thereafter, the applicant and a co-worker, Charles Finkl, concluded that infrared energy was a significant improvement over the dangerous decades old molten salt bath process for conditioning a small portion, the shank portion, of a die block for the purpose of softening it so it may be easily machined in order to form a mounting shank (see 21 in Figure 4 of the '885 patent). They filed an application on this specific step forward in the mounting shank art more than nine months after the instant application was filed.

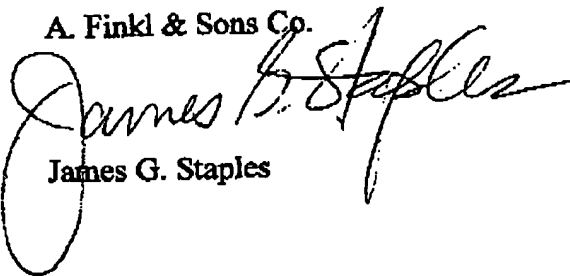
That later filed specie-type shank treatment application (which co-pended over 43 months with the instant application) issued as patent 6,398,885 and is now the basis of a rejection of a dissimilar and much broader concept filed nine months earlier. The offered option of a terminal disclaimer, which recognizes that a patentable distinction exists between

the two applications, in no way compensates applicant for the 3-5 years of existence of the patent which will issue on this application beyond the '885 expiration. The patent which will issue on this application will cover literally dozens of procedures in the steel industry which are art recognized as significantly distinct from the highly specialized art of softening of the shank portion of a prehardened die block, said highly specialized art representing less than .1 of 1% of all steel industry products and processes.

Withdrawal of the rejection is respectfully requested.

Respectfully submitted,

A. Finkl & Sons Co.

A handwritten signature in dark ink, appearing to read "James G. Staples". The signature is written in a cursive style with a large, looping initial "J".

James G. Staples

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